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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,223	10/28/2003	Perriann M. Holden	810101-3	4944
33651	7590	09/07/2005	EXAMINER	
JERRY RICHARD POTTS 3248 VIA RIBERA ESCONDIDO, CA 92029			HOEY, ALISSA L	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/695,223

Applicant(s)

HOLDEN, PERRIANN M.

Examiner

Alissa L. Hoey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 13-31 is/are pending in the application.
- 4a) Of the above claim(s) 4,19,20,22-24,26 and 28-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 13-18, 21, 25 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This is in response to amendment of 06/17/05. Claims 1, 5, 13-18 and 21 have been amended and claims 22-31 have been newly added. Claims 1, 5, 13-18 and 22-31 are examined below.

### ***Election/Restrictions***

2. Newly submitted claims 22-24, 26 and 28-31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the originally prosecuted invention required only a coating of an adhesive layer which is compatible to the user's skin. The newly added claims detail a multiple adhesive construction and is being elected out at this time. However, these claims will be allowed into the case upon the allowance of an independent generic claim.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-24, 26 and 28-31 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the amended language in claim 1 detailing the "planar body" is not supported in the specification.

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4. Claims 13 and 25 are objected to because of the following informalities: both claims 13 and 25 claim exactly the same limitations. Appropriate correction is required.

***Double Patenting***

5. Claims 1, 5, 13, 15-18 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent application No. 10/454,236 and 09/910,641. Although the conflicting claims are not identical, they are not patentably distinct from each other because.

In regard to claim 1, both 10/454,236 and 09/910,641 teach a decorative and disposable fashion wear for the body parts that also protects the decorated body parts from abrasion. A flexible pad having a top surface and a bottom surface and a reusable adhesive material on the top surface for removably securing the pad to a body part. A removable layer covering the adhesive material and a layer of either hooks or piles secured to the bottom surface for providing it with a textured finish (claims 1, 3 and 6 in both applications). The pads of 10/454,236 and 09/910,641 are capable of being provided in a novelty kit.

In regard to claim 5, both 10/454,236 and 09/910,641 teach the material selected from cushioning, magnetic, and gel disposed in the pad between the top surface and the bottom surface (claim 5).

In regard to claims 13 and 25, both 10/454,236 and 09/910,641 teach the pad being sufficiently flexible to conform to the contour of a user's selected body

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part consisting of a group of body parts selected from the feet, toes, knees and elbow or a user to provide protection for the body part selected. The pad of 10/454,236 and 09/910,641 are capable of conforming to user's hands and fingers as desired (claim 4 and 7).

In regard to claim 15, both 10/454,236 and 09/910,641 teach a pad that is trimmable and disposable after use (claims 1 and 2).

In regard to claim 16, both 10/454,236 and 09/910,641 teach a top surface including decorative indicia selected from the group consisting of color, patterns, messages, trademarks and advertisements (claim 2).

In regard to claim 17, both 10/454,236 and 09/910,641 teach a pad that has a body protecting material disposed between its top and bottom surfaces (claim 6).

In regard to claim 18, both 10/454,236 and 09/910,641 teach a body protecting material being selected from a cushioning, a magnetic material and a gel material (claims 5).

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. There is no support in the disclosure that "the attachment engaging surface is covered throughout with a layer of either hooks or piles" is critical or essential to the practice of the invention, but not included in

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the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The only description of the hooks and piles/thistle cloth in the originally filed disclosure requires that it "partially covers" there is no indication in the specification that it is required to be "covered throughout".

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1, 5, 13, 14, 15, 18, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porcelli (US 5,678,273).

In regard to claim 1, Porcelli teaches a fashion wear item (10) for the body. A flexible pad (11) having a top planar body engaging surface and a bottom attachment engaging surface and a reusable adhesive material (11a) on the top planar surface for removably securing the pad (10) to a body part (see figure 2). A layer of either hooks or piles (12) secured to the bottom surface for providing it with a textured finish (figures 3 and 4). The adhesive material (11a) having a removable covering layer (14) to protect the adhesive when not in use.

However, Porcelli fails to teach the hooks or piles covering the attachment engaging surface throughout.

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In regard to the hooks or piles covering the attachment surface throughout, it would have been obvious to one having ordinary skill in the art to have provided the hooks or piles on only a portion of the attachment surface or throughout the attachment surface because as long as there are hooks or piles located on a portion of the attachment surface the amount is not critical and supported in applicant's specification on page 13, lines 1-3.

In regard to claim 5, Porcelli teaches the pad being a single piece construction composed of a material selected from a cushioning material (11).

In regard to claims 13 and 25, Porcelli teaches the pad (10) being sufficiently flexible to conform to the contour of a users selected body part consisting of a group of body parts selected from the hands, fingers, feet, toes, knees and elbow or a user to provide protection for the body part selected (figures 5 and 6).

In regard to claim 14, Porcelli teach the pad (11) being selected from a group of materials consisting of rubber, fabric, paper, plastic, synthetic materials, leather and polyurethane foam (column 3, lines 46-56).

In regard to claim 15, Porcelli teaches a pad (11) that is capable of being trimmable and disposable after use (column 3, lines 46-56).

In regard to claim 18, Porcelli teaches a body protecting material being a cushioning material (column 3, lines 46-56).

In regard to claim 21, Porcelli teaches an adhesive that is skin compatible and it is inherent that a skin compatible adhesive is non irritating to the user's

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skin (column 4, lines 10-14). Further, it is inherent that the decorative device of Sullivan can be reused after the first application.

10. Claims 16, 17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porcelli in view of Yonkers (US 3,985,383).

In regard to claim 17, Porcelli teaches a pad (10) that has a body protecting material (12) disposed between it's top (26) and bottom surfaces (22).

However, Porcelli fails to teach the top attachment engaging surface includes a decorative indicia selected from color, patterns, messages, trademark or advertisements.

In regard to claims 16 and 27, Yonkers teaches a finger engaging pad having a top surface including decorative indicia selected from the group consisting of color, patterns, messages, trademarks and advertisements.

It would have been obvious to have provided the finger engaging pad of Porcelli with the decorative engaging surface of Yonkers, since the finger engaging pad of Porcelli provided a decorative surface would produce a finger pad that was not only functional but aesthetically appealing.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1, 5, 13-18 and 22-31 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**



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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

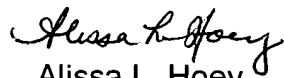
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (571) 272-4985. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (571) 272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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